

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 57

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID T. GREEN, HENRY BOLANDS, SALVATORE CASTRO, HENRY
SIENKIEWICZ, STEPHAN A. DeFONZO, DOUGLAS J. CUNY,
and WAYNE P. YOUNG

Appeal No. 2001-2563
Application No. 08/814,757

ON BRIEF¹

Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12 through 14, 17, 18, 26, 35, 48, 51, 54 through 56, 72, and 73. These claims constitute all of the claims remaining in the application.

¹ Attendance at the hearing set for Tuesday, January 15, 2002 was waived by appellants (Paper No. 54).

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Appellants' invention pertains to a seal assembly. A basic understanding of the invention can be derived from a reading of exemplary claim 12, a copy of which appears in the APPENDIX to the brief filed March 31, 2000 (Paper No. 48).

As evidence of obviousness, the examiner has applied the documents listed below:

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|--------------------------|-----------|---------------|
| Suzuki et al (Suzuki) | 4,673,393 | Jun. 16, 1987 |
| Merry et al (Merry) | 4,929,235 | May 29, 1990 |
| Guest et al (Guest) | 5,000,745 | Mar. 19, 1991 |

The following rejections are before us for review.

1. Claims 12 through 14, 17, 18, 26, 35, 48, 51, 54 through 56, 72, and 73 stand rejected under 35 U.S.C. § 112, first paragraph (lack of enablement).

2. Claims 12 through 14, 17, 18, 26, 35, 48, 51, 54 through 56, 72, and 73 stand rejected under 35 U.S.C. § 112, second paragraph (indefiniteness).

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3. Claims 12 through 14, 17, 18, 26, 35, 48, 51, 54 through 56, 72, and 73 stand rejected under 35 U.S.C. § 112, first paragraph (lack of descriptive support due to indefiniteness).

4. Claims 12 through 14, 18, 26, 35, 48, and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guest.

5. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Guest in view of Merry.

6. Claims 51, 54, 55, 72, and 73 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Guest in view of Suzuki.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the final rejection and answer (Paper Nos. 39 and 49), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 48 and 50).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,² the applied teachings,³ and the respective viewpoints of appellants and the examiner.⁴ As a consequence of our review, we make the determinations which follow.

² We are instructed by footnote 1 in appellants' main brief (page 3) that pursuant to a restriction requirement the species of Figs. 10 through 14 is being prosecuted in this application.

³ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

⁴ It is highly inappropriate and most regrettable that the examiner failed to comply with the proper USPTO practice of fully and directly responding to appellants' arguments on appeal in the argument section of the answer.

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We cannot sustain any of the examiner's rejections on appeal. Our reasoning in support of this conclusion appears below.

The first, second, and third rejections

We have considered all claims specifically addressed by the examiner in the body of the first, second, and third rejections, i.e., claims 12, 26, 51, 72, and 73. The major focus of the examiner's concern in these rejections appears to be directed to the matter of the recited at least one retainer element with its plurality of adjacent movable portions each defined by a pair of slits (claim 12). In reviewing these lack of enablement, indefiniteness, and lack of descriptive support rejections, we have read the language of appellants' claims in light of the underlying disclosure. From that perspective, we readily conclude that the language at issue is broad but definite in meaning, descriptively supported by the underlying disclosure, and enabled by the description found in appellants' specification and derived from the drawings. As to claim 26, and contrary to the examiner's point of view, we do not consider the overall recitation therein as redundant or indefinite. Thus, each of the

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examiner's first, second, and third rejections is not sound and cannot be sustained.

The fourth, fifth, and sixth rejections

The respective obviousness rejections are based upon the teaching of Guest alone, and in combination with Merry and Suzuki, respectively.

Appellants' sole independent claim 12 sets forth a seal assembly which comprises, inter alia, a frame and at least one sealing gasket assembly including a first sealing element defining a first semi-circular opening and having a first wall and a second sealing element defining a second semi-circular opening and having a second wall, wherein mounting of the at least one sealing gasket onto the frame tensions the first and second walls so that they overlap to define overlapping walls and form a substantial gas and fluid tight seal in the absence of an instrument inserted through the semi-circular openings.

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A reading of appellants' specification and claim 12 makes it quite clear to us that a significant feature of the claimed invention is the tensioned first and second walls of the at least one sealing gasket assembly with its first and second sealing elements defining respective first and second semi-circular openings. Of the Guest, Merry, and Suzuki patents applied by the examiner, it is at once quite apparent to this panel of the board that not a single one teaches or would have been suggestive of the noted feature in appellants' claim 12. In other words, the rejections before us provide NO EVIDENCE WHATSOEVER of the aforementioned feature, when it is EVIDENCE that is the essential underpinning of rejections under U.S.C. 103(a). The examiner's attempt to shore up the lack of evidence by reliance upon the Kuhle decision is clearly misplaced on the facts of the present case (final rejection, pages 4 and 5). Since the rejections lack sound evidence of obviousness as to the claimed subject matter, the respective rejections under 35 U.S.C. 103(a) cannot be sustained.

In summary, this panel of the board has not sustained any of the rejections on appeal.

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The decision of the examiner is reversed.

REVERSED

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| IRWIN CHARLES COHEN |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| |) | |
| JENNIFER D. BAHR |) | |
| Administrative Patent Judge |) | |

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